

REMARKS

The present Amendment is responsive to the Examiner's Office Action dated August 10, 2007. By way of summary, Claims 1-3 were pending in this application. Applicants have hereby amended Claims 1 and 2. Thus, Claims 1-3 remain pending in this application. Reconsideration of the application in view of the foregoing amendments and following comments is respectfully requested.

The Examiner rejected Claims 1-3 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,544,249 B1 to Yu et al. (hereafter "Yu"), and under 35 U.S.C. § 103(a) as being obvious in view of the combination of U.S. Patent No. 6,827,700 B2 to Lynch et al. (hereafter "Lynch") and U.S. Patent No. 5,092,837 to Ritch et al. (hereafter "Ritch").

Applicants respectfully traverse these rejections and the Examiner's characterization of the cited references on the bases set forth below. In this case, Claim 1 has been amended for clarification purposes only and not to distinguish over the cited references. Claim 2 has been amended to correct a typographical error, as shown above.

Claims 1-3 are Not Anticipated by Yu

Applicants' independent Claim 1 is directed to a glaucoma treatment kit and recites, among other things (emphasis added):

wherein a long axis of a flow path of the inflow portion is disposed *generally transversely* to a long axis of a flow path of the outflow portion when the implant is releasably held by the applicator.

Yu fails to teach or suggest this and discloses a microfistula tube (10) with a straight or linear drainage canal (15) as shown in FIG. 1. Thus, Yu cannot possibly anticipate Claim 1. Claims 1 and 2 depend from independent Claim 1 and are not anticipated by Yu for at least the same reason(s) that Claim 1 is not, and because of the unique combination of features recited therein.

Claims 1-3 are Patentable Over the Combination of Lynch and Ritch

The Examiner asserted that it would be obvious to one of ordinary skill in the art to combine the ocular implant of Lynch with the insertion method of Ritch.

Applicants respectfully disagree with the Examiner's assertion. Applicants acknowledge that Lynch discloses various shunts (100) and Ritch discloses an implantation instrument (16) to deliver an inset member (21). However, there is no teaching in Ritch of modifying the implantation instrument (16) to deliver a shunt (100) having structural features as disclosed by Lynch. Not even hindsight would provide such a teaching.

Moreover, Applicants would like to point out that Lynch ('700 patent) is not prior art to the present application. It should be noted that the Lynch patent has a filing date later than the priority date of the present continuation application. As referenced on page 1 of thereof, the present application is a continuation of U.S. Application No. 10/395,627, now U.S. Patent No. 6,780,164, which is a continuation of U.S. Patent Application No. 09/549,350, filed April 14, 2000, now U.S. Patent No. 6,638,239. The pertinent disclosures in all three related applications are the same. Additionally, co-pendency existed between the present application and the parent application (i.e., the '627 application) and between the parent application (i.e., the '627 application) and the grandparent application (i.e., the '350 application).

The pending claims thus have an effective filing date of April 14, 2000. In contrast, the Lynch patent has a filing date of April 26, 2000, and while the Lynch patent claims priority to a provisional application 60/131,030 (hereafter "the Lynch provisional"), that disclosure does not provide support for many features disclosed in the Lynch patent.

In particular, the Lynch provisional only discloses a T-shaped shunt device. The implantation instrument (16) disclosed in Ritch simply cannot be used to deliver a T-shaped shunt as disclosed in the Lynch provisional.

As such, Applicants submit that Claim 1 is patentable over the applied combination. Claims 2 and 3 depend from independent Claim 1 and are patentable for at least the same reason(s) that Claim 1 is patentable, and because of the unique combination of features recited therein.

Double Patenting Rejections

The Examiner provisionally rejected Claims 1 and 2 on the ground of obviousness-type double patenting as being unpatentable over claims 1, 3 and 5 of co-pending U.S. Patent Application No. 11/121,584 (U.S. Patent Application Publication No. 2005/0192527 A1) to Gharib et al.

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Applicants will file a terminal disclaimer when the provisional nonstatutory obviousness-type double patenting rejections are the only rejections remaining in the application, as provided at M.P.E.P. § 804, subsections I.B. Thus, Applicants respectfully request that the Examiner provide Applicants the opportunity to file a terminal disclaimer once allowable subject matter has been determined.

The Examiner also rejected Claims 1-3 on the ground of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,780,164 B2 to Bergheim et al. in view of U.S. Patent No. 6,827,700 B2 to Lynch et al.

Though the Examiner refers to claims 1-9 of the '164 patent, this patent has only 6 claims. Moreover, Applicants do not properly understand the reasoning presented in the second paragraph on page 6 of the outstanding Office Action. For example, it is not clear what the Examiner means when he refers to "Claim 5 of the patent discloses an instrument for delivering implants ..." and "the application '213 claim 5" when trying to explain the double patenting rejection. Applicants respectfully request clarification of this double patenting rejection.

On clarification of the above, Applicants will file a terminal disclaimer.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

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Co-Pending Applications of Assignee

Applicants wish to draw the Examiner's attention to the following co-pending applications of the present application's assignee.

Serial Number	Title	Filed	Attorney Docket No.
11/836,118	GLAUCOMA IMPLANT WITH VALVE	August 8, 2007	GLAUKO.1C2C2C
10/889,254	GLAUCOMA IMPLANT WITH BI-DIRECTIONAL FLOW	July 12, 2004	GLAUKO.1C2C3

Conclusion

Applicants respectfully submit that the claims are in condition for allowance in view of the above remarks. Any remarks in support of patentability of one claim, however, should not be imputed to any other claim, even if similar terminology is used. Additionally, any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicants respectfully traverse each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby.

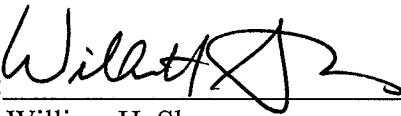
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Applicants have made a good faith effort to respond to the outstanding Office Action. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is cordially invited to contact Applicants' attorney, at the telephone number below, to resolve any such issues promptly. Also, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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